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Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/276,016 03/25/99 PASQUALI

S 040.0023

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TM02/0427

ERIK B. CHERDAK & ASSOCIATES, LLC  
11300 ROCKVILL PIKE  
SUITE 906  
ROCKVILLE MD 20852

EXAMINER
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PRIETO, B

ART UNIT	PAPER NUMBER
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2152

DATE MAILED:

04/27/01

12

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

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# Advisory Action

Application No.  
09/276,016

Applicant(s)

PASQUALI

Examiner

Beatriz Prieto

Group Art Unit

2152



## THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☒ expires 3 months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on \_\_\_\_\_ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Apr 12, 2001 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

### ☒ The proposed amendment(s):

- ☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.

### ☒ will not be entered because:

- ☒ they raise new issues that would require further consideration and/or search. (See note below).
- ☐ they raise the issue of new matter. (See note below).
- ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: Proposed amendment further limiting the claimed software package to include at least one network navigation destination instruction and a plurality of pre-configured sentence parts, as oppose to said package further facilitating the construction of said parts, as previously claimed, would require further consideration.

- ☐ Applicant's response has overcome the following rejection(s):

- ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

- ☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:

(see attached supplemental advisory action).

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: None

Claims objected to: None

Claims rejected: 1-25

- ☐ The proposed drawing correction filed on \_\_\_\_\_ ☐ has ☐ has not been approved by the Examiner.

- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

- ☐ Other

LE HIEN LUU  
PRIMARY EXAMINER

*Supplemental Advisory*

1. This communication is in response to After-Final Amendment/Response filed 04/12/01, claims 1-25 remain pending.

2. Regarding requested change of address, new corresponding address has been made of record; (see Palm printout).

3. Regarding arguments presented on pages 5-15, it is argued prior art of record does not teach claim limitation as amended, where presented amendment comprising: "...a plurality of pre-configured navigation options.. pre-configured sentence parts included within said software package...", wherein said amendment to the claim language allegedly is distinguishable over the prior art, and is to be read as meaning a data base or other software package (that is downloaded to a network client or browser, for example), as per remarks page 9, last paragraph, wherein further the sentence parts of the presented inventions may be present in the form of a list that are stored with a served software object (e.g. a data base, etc.) as per remarks argued on page 10, wherein in further prior art (Rubinstein) teaches nothing of *selecting pre-stored sentences parts that may be server with a data object such as a database sent from a server*, etc, as defined on amendment claims 1-25.

4. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "*selecting pre-stored sentences parts that may be server with a data object such as a database sent from a server*") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case, it is respectfully noted that the further incorporation of claim language used as the bases of presented afterfinal arguments given the prior arts of record considered in their entirety, would not render claimed invention "clearly and patentable distinguishable over the prior arts of record" as argued on page 7 of remarks.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Prieto, B.** whose telephone number is **(703) 305-0750**. The Examiner can normally be reached on Monday-Friday from 6:30 to 4:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, **Mark H. Rinehart** can be reached on **(703) 305-4815**. The fax phone number for the organization where this application or proceeding is assigned is **(703) 308-6606**. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is **(703) 305-3800/4700**.

Any response to this action should be mailed to:  
Commissioner of Patents and Trademarks  
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)  
Or:  
(703) 305-7201 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Fourth Floor (Receptionist), further ensuring that a receipt is provided stamped "TC 2100".

B. Prieto  
Patent Examiner  
April 24, 2001



**LE HIEN LUU**  
**PRIMARY EXAMINER**

## Correspondence Address for 09/276016

Customer Number	Contact Information	Address
No Customer#	Telephone: No Telephone# Fax: No Fax# E-Mail: No E-Mail Address	ERIK B. CHERDAK & ASSOCIATES, LLC 11300 ROCKVILL PIKE SUITE 906 ROCKVILLE , MD 20852

Appin Info	Contents	Details	Atty/Agent Info	Continuity Data	Foreign Data	Inventors	Address
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Back to || [PALM](#) || [ASSIGNMENT](#) || [OASIS](#) || Home Page

## Content Information for 09/276016

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Appln Info	Contents	Details	Atty/Agent Info	Continuity Data	Foreign Data	Inventors	Address
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Num	Type	Date	Code	Contents Description
23	O	04/23/2001	C.AD	ICORRESPONDENCE ADDRESS CHANGE - ONLY P/E
22	E	04/23/2001	FWDX	DATE FORWARDED TO EXAMINER
21	I	04/12/2001	A.NE	RESPONSE - NOT ENTERED
20	I	04/12/2001	XT/G	FIRST REQUEST FOR EXTENSION OF TIME GRANTED (INCLUDING TO FILE BRIEF)
19	O	11/14/2000	MAIL	MAIL DATE OF OFFICE ACTION
18	O	11/13/2000	CTFR	COUNT DATE-FINAL REJECTION; IF TYPE F-1ST ACTION; IF TYPE M-2ND/PLUS ACTION FAOM; IF TYPE O-ALL OTHER ACTIONS
17	I	10/02/2000	M844	PRIOR ART CITATION FILED P/E
16	D	10/06/2000	DOCK	DATE CASE WAS DOCKETED
15	E	09/12/2000	FWDX	DATE FORWARDED TO EXAMINER
14	I	08/31/2000	A...	RESPONSE AFTER NON-FINAL ACTION
13	I	08/31/2000	XT/G	FIRST REQUEST FOR EXTENSION OF TIME GRANTED (INCLUDING TO FILE BRIEF)
12	O	05/23/2000	MAIL	MAIL DATE OF OFFICE ACTION
11	F	05/22/2000	CTNF	COUNT DATE-NON-FINAL ACTION; IF TYPE F-1ST ACTION; IF TYPE M-2ND/PLUS ACTION FAOM; IF TYPE O-ALL OTHER ACTIONS
10	D	05/10/2000	DOCK	DATE CASE WAS DOCKETED
9	D	04/28/2000	DOCK	DATE CASE WAS DOCKETED
8	D	03/21/2000	DOCK	DATE CASE WAS DOCKETED
7	L	02/17/2000	G013	LOCATION CHANGE IN PRE-EXAM
6	D	02/03/2000	DOCK	DATE CASE WAS DOCKETED
5	I	06/28/1999	OIPE	APPLICATION DISPATCHED FROM PRE-EXAM
4	E	06/23/1999	COMP	APPLICATION IS NOW COMPLETE
3	O	04/15/1999	INCD	INCOMPLETE APPLICATION UNDER RULE 53(B) - FILING DATE ASSIGNED
2	E	04/09/1999	SCAN	APPLICATION SCANNED
1	E	03/31/1999	IEXX	INITIAL EXAM TEAM XX

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(To Go BACK Use BACK Button on Your BROWSER Tool Bar)

Back to || [PALM](#) || [ASSIGNMENT](#) || [OASIS](#) || Home Page

**ATTACHMENT TO AND MODIFICATION OF**  
**NOTICE OF ALLOWABILITY (PTO-37)**

*(November, 2000)*

**NO EXTENSIONS OF TIME ARE PERMITTED TO FILE CORRECTED OR FORMAL DRAWINGS, OR A SUBSTITUTE OATH OR DECLARATION**, notwithstanding any indication to the contrary in the attached Notice of Allowability (PTO-37).

If the following language appears on the attached Notice of Allowability, the portion lined through below is of no force and effect and is to be ignored<sup>1</sup>:

A SHORTENED STATUTORY PERIOD FOR RESPONSE to comply with the requirements noted below is set to EXPIRE **THREE MONTHS** FROM THE "DATE MAILED" of this Office action. Failure to comply will result in ABANDONMENT of this application. ~~Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).~~

Similar language appearing in any attachments to the Notice of Allowability, such as in an Examiner's Amendment/Comment or in a Notice of Draftperson's Patent Drawing Review, PTO-948, is also to be ignored.

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<sup>1</sup> The language which is crossed out is contrary to amended 37 CFR 1.85(c) and 1.136. See "Changes to Implement the Patent Business Goals", 65 Fed. Reg. 54603, 54629, 54641, 54670, 54674 (September 8, 2000), 1238 Off. Gaz. Pat. Office 77, 99, 110, 135, 139 (September 19, 2000).